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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,771	10/09/2001	Philip Bush	2334-194	2486

7590

11/25/2002

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EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
1731	9

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/971,771

Applicant(s)

BUSH ET AL.

Examiner

José A Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 26-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of species of claims 1-25 in Paper No. 8 is acknowledged.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bondoc et al., WO 97/16483, referred hereafter as "Bondoc."

Regarding Claims 1-16, Bondoc teaches a sheet felt made using cellulosic fibers, Glass fibers and a non-asphaltic sizing agent, see abstract. Bondoc teaches that the sizing is added at a rate of 0.5-10 wt.% and that one of the preferred sizing agent is alkenyl succinic acid anhydride, page 10, last paragraph. Bondoc teaches also that the sizing agent is added in a aqueous solution, emulsion or dispersion having a solid content between 30-70%, which implies that the dry solid add on rate is within the claimed range, as claimed in claims 3-4, 8-9, 11-2 and 15-16, i.e., addition of 0.5-10 wt% of sizing agent in which only 30-70% is the sizing agent gives an range between .15 to 7 wt.% dry basis. Note here that no weight has been given to the source of the fibers since these claims are product claims and the final product would have the same

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composition, i.e., glass and cellulosic fibers in the same proportion. There is no evidence that the recycled fibers are structurally, physically or chemically different than the non-recycled fibers.

Note also that as it would be discussed below the use of recycled fibers is well known in the art.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Column.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 17-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of applicants admission.

Bondoc's invention has been explained above. Bondoc fails to teach the use of recycled glass fibers. However, the use of recycled glass fibers in non-woven webs, such as roofing, glass reinforced felt or sheet felt, etc., is well known in the art as admitted by applicants in page 3, line 17 through page 4, line 31, and more specifically in page 4, lines 5-7, (evidence of this fact is also shown in the cited references). Therefore, substitution of the glass fibers taught by the reference for recycled glass fibers would have been obvious to one of ordinary skill in the art, since the fibers would have the same properties. Note that it has been held that "[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967). Note that independently of the source the glass fibers need to have certain physical properties, such as diameter or length, etc., to function in the process. Regarding the dependent claims, see 102(b) rejection above for rejection of the counterpart claims.

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7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of applicants admission as applied to claims 16-21 and 23-25 above, and further in view of Schueler, GB 1 275 042..

The combination of Bondoc and admission of prior art fails to teach the use of untreated clarified sludge in the process. However, Schueler teaches that using clarified waste slurry helps in the matting process in the formation of insulation board in which other fibers are also used, see page 2, lines 10-45. Therefore, it would have been obvious to use clarified waste sludges along with other fibers of Bondoc felt in order to increase the matting of the fibers.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Sheet Felts."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (703)308-1164. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other

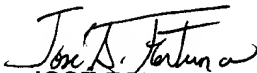
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communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José a. Fortuna
November 20, 2002


JOSE FORTUNA
PRIMARY EXAMINER
ART UNIT 1731